

### **DETAILED ACTION**

1. This is the first Office action on the merits of Application No. 10/566,444, filed 07 August 2006. Claims 4-9 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - Foreign Priority Document, received on 01/31/06
  - Information Disclosure Statement, received on 01/31/06
  - Declaration and Power of Attorney, received on 08/07/06

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4-7 are directed to method of operating a drive system but, since the claims do not set forth any active, positive steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

5. Claims 4-7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for

example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S.**

**Patent No. 6,319,167 to Yoshida et al.**

**Claims 8 and 9:**

Yoshida (Figs. 1-15; column 2, line 49 – column 15, line 36) discloses a transmission control system comprising:

- An electric motor (i.e., Fig. 1, element 300);
- A drive shaft (i.e., Fig. 1, element 219) of internal combustion engine (i.e., Fig. 1, element 200);
- A clutch (i.e., Fig. 1, element 310);
- Wherein the electric motor is integrated with the drive shaft of the internal combustion engine (i.e., Fig. 1);
- Wherein the method includes the steps of:
  - Using the internal combustion engine to propel the vehicle (i.e. Fig. 1);

- During a disengagement of the clutch for gear shifting causing the electric motor to accelerate a rotational speed of the drive shaft (i.e., column 6, line 57 - column 10, line 15); and
- Engaging the clutch when the rotational speed reaches a predetermined value (i.e., column 6, line 57 - column 10, line 15).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sakamoto et al. (U. S. Patent No. 6,722,230) teaches a power transmission, as shown in Fig. 1.
- Suzuki (U. S. Patent No. 6,342,027) teaches a hybrid motive power vehicle, as shown in Fig. 1.
- Nitta et al. (U. S. Patent No. 6,203,468) teaches a control device for a hybrid vehicle and a method thereof, as shown in Fig. 5.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0900-1730).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David D. Le/  
Primary Examiner, Art Unit 3655  
10/21/2008

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